

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re certain patents of:
Marty Williams et al.

Application No. 09/100,808
Filed: June 19, 1998
Title: Equipment Trailer

U.S. Patent No. 6,042,175
Issued: March 28, 2000

Application No.: 09/336,887
Filed: June 18, 1999
Title: Equipment Transportation System

U.S. Patent No. 6,213,539
Issued: April 10, 2001

Application No.: 09/681,287
Filed: February 9, 2001
Title: Equipment Transportation System

U.S. Patent No. 6,398,290
Issued: June 4, 2002

Statement of Facts in Support of Petition to Revive under 37 CFR 1.378(b)

The undersigned does hereby provide the following statement of facts relevant to the abandonment of U.S. Patents Nos. 6,042,175; 6,213,539 and 6,398,290.

I was the attorney of record responsible for the prosecution of the applications for U.S. Patents Nos.: 6,042,175, issued on March 28, 2000; 6,213,539, issued on April 10, 2001; and 6,398,290, issued on June 4, 2002; all of which are owned by Let's Go Aero, Inc. The first maintenance fee for the '175 patent was timely paid. The second maintenance fee was due on March 28, 2007, with the window closing on 3/28/2008. A discussion with Marty Williams and the undersigned occurred at some point prior to that time in regard to the payment of the U.S and international patent maintenance fees, the cash flow of the company, the discontinuance of the product line, and that the claim protection provided by the claims of that patent were covered by broader claims in subsequently issued continuation and continuation-in-part patents. The decision, as understood by the undersigned, was to drop the maintenance of the US patent and international patent applications at that time and to concentrate the company's cash flow into new designs. Thus the maintenance fees of the '175 patent were not paid.

The maintenance fees for the '539 patent were due no later than October 13, 2004, and for the '290 patent were due no later than December 6, 2005. These fees were not timely paid and the '539 patent expired on April 10, 2005 and the '290 patent expired on June 4, 2006. The undersigned fully supports the reinstatement of these two patents and recognizes that these patents apparently went abandoned due to inadequacies in the docketing and client notification systems of the undersigned which have subsequently been rectified.

It has been my policy to promptly copy correspondence from the U.S. Patent Office into the client file, enter the requisite response and due date for the response into the office docketing system and to notify the client if instructions from the client are required for responding to the action. Additionally, at the time of issuance of a patent, the dates for payment of the issued patent is entered into the docketing system. The

docketing system is redundant, with entries into Office Books Professional Legal Services and into Microsoft Outlook Calendar. The timing process is for a tickler to pop up one month prior to the response due date, one week prior to the date and the actual date. The tickler is dismissed and there is no record maintained once the tickler is dismissed. This process is intended to be performed by an office assistant under the supervision of an attorney. The undersigned went through a law firm break up during 2004/2005 during which there was considerable friction between the respective attorneys and with members of the office staff. It appears in retrospect, that the maintenance fee reminders for the '539 and '290 patents were not transferred to the new docketing system from the previous law firm. During the time period of late 2005 through 2007, and due to the undersigned's status as a solo practitioner, often the office assistant was a temporary worker, and occasionally the undersigned performed this function. A review of the files for these two patents do not show that a reminder for maintenance fee was received and copied into the file, nor that the client was notified in regard to the necessity of the maintenance fee payment, nor any notice of abandonment. There is no record of the due dates for the payments into the docketing system which should have been done at the time of the issuance of the patent as well upon receipt of the maintenance fee reminder. However, these records would have been dismissed if they had been entered, thus no record would have been maintained. The above-described policy did not function as intended and has been subsequently improved to ensure that such actions do not occur in the future.

The undersigned became aware of the abandonment of the '539 patent and the '290 patent by Marty Williams on June 18, 2008. The licensor of these patents notified Mr. Williams of the status of those three patents at that time during their due diligence. (See Exhibit A) Mr. Williams contacted me, I affirmed after review that the '175 patent, '539 patent and '290 patent had become abandoned, reminded him of the decision to abandon the '175 patent, and discussed the possibilities of reviving the three patents, along with the costs for doing so, and who would be responsible for paying portions of the costs (I would pay the revival fees, the company would be paying maintenance fees). Mr. Williams then decided to discuss the issues with the licensor and would further instruct me at a later time. Apparently, there was a miscommunication between the parties as to whether I had been instructed to prepare and file petitions to revive the patent applications. I have no recollection for being instructed to prepare and file petitions for revival for any or all of the above-identified patents, nor do I have any records providing such instructions. However, it does appear as though Mr. Williams was of the impression that I had been instructed to proceed. (See Exhibit B) The petitions were not prepared or filed, no payments from the client were received for payment of the maintenance fees which is normal practice prior to extending payment for out of pocket expenses, nor was the undersigned contacted by the client at any time to ascertain the status of the petitions or the status of the abandoned patents. Thus, there appears to be genuine miscommunication between Mr. Williams and the undersigned.

There was no further follow-up between the undersigned and Mr. Williams in regard to these two patents until on or about February 2, 2010, when the licensor once again notified Mr. Williams that the three above-identified patents had lapsed. (See Exhibit C) This matter was discussed with Mr. Williams at that time, and the recommendation was made to attempt to revive the '290 patent as the claims in that patent

substantially encompassed the claims of the '539 and '175 patents. (See Exhibit D) Mr. Williams instructed the undersigned not to go forward until he had discussed it with the licensor. The licensor had engaged an in-house patent attorney, and Mr. Williams advised the undersigned not to go forward until he had received instructions from the licensor and their patent attorney. (See Exhibit E) No further action was taken until May 17, 2010 when Mr. Williams was advised that his company may be in breach of the license agreement due to the lapsed patents. At that time, Mr. Williams engaged the services of Mr. Heims to assist with the revival of the above-identified patents. The undersigned on June 18, 2010 received from Mr. Williams a copy of the petition to revive that Mr. Heims intended to file. The undersigned then expressed his concern that the petition contained numerous errors and misstatements as well as failed to inform the U.S. Patent Office of the material facts relevant to the circumstances of the failure to timely pay the maintenance fees as required under 37 CFR 1.378(b) and the duty of candor to the U.S. Patent Office to both Mr. Williams and Mr. Heims. The undersigned also provided documents detailing some of the facts set forth above that had not been set forth in the petition. The undersigned has not been provided any information in regard to any revisions to the petition to revive.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of the Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

By: Glenn L. Webb

Date: June 28, 2010

Glenn L. Webb Reg No. 32668
PO 3788
Durango, CO 81301
(970) 459-4646



Glenn L. Webb <glenn.l.webb@gmail.com>

Additonal patent numbers lapsed.....also 6,910,609 is active but due for renewal.....?

3 messages

Marty L. Williams <mwilliams@letsgoaero.com>

Wed, Jun 18, 2008 at 8:31 AM

To: Glenn Webb <glenn@webbpatlaw.com>

Hello Glenn,

Cequent called this morning and they ID'd three more issuances of ours that apparantly have lapsed?

Could you take a look at numbers 6,042,175, 6,213,539 and 6,398,290 to see what's up?

Thanks,
Mlw

Glenn L. Webb <glenn@webbpatlaw.com>

Wed, Jun 18, 2008 at 11:35 AM

Reply-To: glenn@webbpatlaw.com

To: "Marty L. Williams" <mwilliams@letsgoaero.com>

Cc: "Glenn L. Webb" <glenn.l.webb@gmail.com>

Marty,

Just got back from doctor's appointment. Those three you listed all relate to Herman. We discussed this a few years ago, and LGA decided not to spend additional money on Hermann patents (the international applications in particular were getting expensive). We can look at reviving them, but not sure it is worth it on a product not in production.

The payment window for the '09 patent is currently open. If we pay it by June 28, the fee is \$930. After June 28, the fee will be \$1060.

I will give you a call once I have a chance to catch my breath.

Regards,

Glenn L. Webb
PO 951
Conifer, CO 80433
(303) 816-4893
(303) 817-5018 cell
(303) 484-5176 fax

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From: Marty L. Williams [mailto:mwilliams@letsgoaero.com]

Sent: Wednesday, June 18, 2008 8:31 AM

To: Glenn Webb

Subject: Additonal patent numbers lapsed.....also 6,910,609 is active but due for renewal.....?

[Quoted text hidden]

Marty L. Williams <mwilliams@letsgoaero.com>

Wed, Jun 18, 2008 at 11:43 AM

To: Glenn Webb <glenn@webbpatlaw.com>

Thanks Glenn,

Yes, please call me asap. I remember the Herman EU renewal being expensive relative to the opportunity, so we did decided not to renew Herman in the EU.....but to keep it alive in the US, due to much smaller fees and good application for the IP here.

The 290 relates to GS-34 (remora) and this one is important. The 609 is easy as we are just at the "window". The 539 being over three years old may be un-renewable, presuming it makes sense to try.

So please ring me so we can discuss and get a plan in place.

mlw

Marty,

[Quoted text hidden]

From: Marty L. Williams [mwilliams@letsgoaero.com]
Sent: Wednesday, June 18, 2008 12:51 PM
To: matt; Glenn Webb; sara williams; Eric Nickerson
Subject: FW: Patent lapses

----- Forwarded Message

From: "Marty L. Williams" <mwilliams@letsgoaero.com>
Date: Wed, 18 Jun 2008 12:50:58 -0600
To: Gail Matheus <gmatheus@cequentgroup.com>, Jason Dreger <jdreger@cequentgroup.com>
Conversation: Patent lapses
Subject: Patent lapses

Hello Gail and Jason,

Thanks for bringing the timing issues regarding some of LGA's patents to my attention.

LGA's patent attorney was aware of the short fuse on '290, he has a 6/28 or 7/5 action date to renew it in his system. The '175 and '609 will be renewed as a matter of course.

The '539 involves a miscue between Glenn and I stemming from our mutual decision not to renew it for the E.U. back in 2005.....and this patent fundamentally relates to LGA's original Herman trailer.....which happened during the era of the Reese Backpacker trailer. Glenn and I are in a review of '539 in order to determine whether the content of '175 and '290 have sufficient overlap to the claims in '539 to make renewal of '539 functionally irrelevant.

Thanks,
Marty

----- End of Forwarded Message

Exhibit B



Glenn L. Webb <glenn.l.webb@gmail.com>

FW: Patent Expirations

Marty L. Williams <mwilliams@letsgoaero.com>

Fri, Jan 29, 2010 at 3:48 PM

To: Glenn Webb <glenn@webbpatlaw.com>

----- Forwarded Message

From: Gail Matheus <gmatheus@cequentgroup.com>**Date:** Fri, 29 Jan 2010 16:05:18 -0500**To:** "Marty L. Williams" <mwilliams@letsgoaero.com>**Cc:** Paul Caruso <pcaruso@cequentgroup.com>, Lisa Davidson <ldavidson@cequentgroup.com>, Jason Dreger <jdreger@cequentgroup.com>**Conversation:** Patent Expirations**Subject:** Patent Expirations

Hi Marty,

I received a notice that the following patents expired on 1/2/2010.

11/160087 & 6,213,539 & 6,042,175- GearDeck

6,398,290 & 6,910,609 - GearSpace

09/788299 - TwinTube

11/16008 - JuiceBox

Please let us know that status.

Gail

Gail R. Matheus
General Manager - Cargo Management
47774 Anchor Court West
Plymouth, MI 48170
734-656-3025 (Office)
734-679-5019 (Cell)

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Exhibit C



Glenn L. Webb <glenn.l.webb@gmail.com>

FW: Patent Expirations

Marty L. Williams <mwilliams@letsgoaero.com>

Fri, Jan 29, 2010 at 3:53 PM

To: "Glenn L. Webb" <glenn@rockymtlaw.com>

Glenn,

Please give me a ring on cell when you get this.....719-649-6352.....I'd like to clear this up quickly, as I'm due a response to Cequent.

Thanks,
mlw

[Quoted text hidden]

[Quoted text hidden]

----- End of Forwarded Message

----- End of Forwarded Message



Glenn L. Webb <glenn.l.webb@gmail.com>

FW: Patent Expirations

Glenn L. Webb <glenn@webbpatlaw.com>

Sun, Jan 31, 2010 at 7:20 PM

To: "Marty L. Williams" <mwilliams@letsgoaero.com>

Hi Marty,

Just got back from Oklahoma. I am checking in on the status of these. I am also subscribing to an online service for docketing so these do not fall into the cracks. Of course, the revival fees will be my responsibility. There will be maintenance fees on the issued patents that LGA will be responsible for, I will let you know how much tomorrow. For whatever reason, I did not get the reminders from the Patent Office on these, but still should have caught these. The new docketing service will make sure that will not happen. We can talk about this tomorrow. everything can be fixed, but I am going to be working for free for awhile.

Glenn

[Quoted text hidden]

Regards,
Glenn L. Webb
Intellectual Property Law
PO 3788
Durango, CO 81301
(303) 816-4893



Glenn L. Webb <glenn.l.webb@gmail.com>

FW: Patent Expirations

Marty L. Williams <mwilliams@letsgoaero.com>

Mon, Feb 1, 2010 at 10:02 AM

To: Glenn Webb <glenn@webbpatlaw.com>

Thanks Glenn,

I'll give you a ring a little later.

Regarding 539, in early 2008 when we had another batch of patents and applications go stale, you and I may of decided to let 539 go, as I remember we discussed it's claims overlapping with other issued patents. Do you remember that better than I do, maybe take a look at this one to see if a revival attempt for it makes sense.

Thanks,

m/w

[Quoted text hidden]



Glenn L. Webb <glenn.l.webb@gmail.com>

FW: Patent Expirations

Marty L. Williams <mwilliams@letsgoaero.com>

Tue, Feb 9, 2010 at 9:51 AM

To: Gail Matheus <gmatheus@cequentgroup.com>

Cc: Paul Caruso <pcaruso@cequentgroup.com>, Lisa Davidson <ldavidson@cequentgroup.com>, Jason Dreger <jdreger@cequentgroup.com>, "Glenn L. Webb" <glenn@rockymtlaw.com>

Hello Gail,

Please review Glenn's comments below regarding your email.

Essentially Glenn is suggesting that the '290 patent, in addition to protecting its discrete new claims relative to '175 and '539, also protects the claims in '175 and '539.

I would like to know your thoughts on this, before we make a final decision to let the '175 and '529 lapse, in favor of '290.

Very Truly,
Marty

From: "Glenn L. Webb" <glenn@rockymtlaw.com>

Date: Mon, 8 Feb 2010 09:13:40 -0700

To: Marty L. Williams <mwilliams@letsgoaero.com>

Subject: Expired patents

Hi Marty,

After reviewing the status of the patents and applications, and after our discussions on these items, I have the following recommendations:

The claims of U.S. Patent No. 6,398,290 encompass the claims of the 6,042,175 and 6,213,539 patents. These patents were issued earlier with narrower claims. The '290 patent later issued with broader claims that cover the use of the pivoting lids opening in the center for use on both receiver mounted carriers and on trailers. So there is no advantage in maintaining all three patents. There should be no problem with reinstating the '290 patent.

The claims of the 6,910,609 patent are broad and cover the use of any type of receiver mounted carrier using a C channel style equipment mounting system. This patent survived a reexamination, which confused the issue as to the maintenance fees. There will be no problem reinstating this patent. This patent issued from the 09/788,299 application.

It is my opinion that we should be able to obtain significant patent protection on the JuiceBox/Powerpack application since none of the prior art references disclose using a heat resistant material on the container. So I recommend reinstating this application and pursuing the patent on it.

Please let me know if there are any questions on these patents/applications.

Glenn L. Webb
679 2nd Ave.
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Durango, CO 81301
(303) 816-4893
(970) 459-4646

6/28/2010

Gmail - FW: Patent Expirations

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(877) 812-2364 fax

Hi Marty,

I received a notice that the following patents expired on 1/2/2010.

11/160087 & 6,213,539 & 6,042,175- GearDeck

6,398,290 & 6,910,609 - GearSpace

09/788299 - TwinTube

11/16008 - JuiceBox

Please let us know that status.

Gail

Gail R. Matheus

General Manager - Cargo Management

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Glenn L. Webb <glenn.l.webb@gmail.com>

status

Glenn L. Webb <glenn@rockymtlaw.com>**Wed, Feb 3, 2010 at 4:34 PM**

Reply-To: glenn@rockymtlaw.com

To: "Marty L. Williams" <mwilliams@letsgoaero.com>

Cc: "Glenn L. Webb" <glenn.l.webb@gmail.com>

Hi Marty,

Still working through everything, with a million interruptions.

Here are my recommendations so far:

'175 - limited to a trailer. I don't think Cequent is licensing any products produced under this patent
'539 - '290 - these have equivalent claims, the '290 has more extensive claim coverage. No advantage to keeping the '539 patent alive at this point.

Still working through the power pack rejection and should have recommendations later this afternoon.

Regards,

Glenn L. Webb
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Exhibit D



Glenn L. Webb <glenn.l.webb@gmail.com>

status

Marty L. Williams <mwilliams@letsgoaero.com>

Thu, Feb 4, 2010 at 10:18 AM

To: glenn@rockymtlaw.com

Hello Glenn,

I agree on letting '539 slip under the waves. How do you feel about '175 if it goes away relative to the lid opening claims in it? Are these claims also mirrored strong enough in '290 and other issuances to protect that feature?

mlw

Hi Marty,

[Quoted text hidden]



Glenn L. Webb <glenn.l.webb@gmail.com>

FW: New patent attorney

1 message

Marty L. Williams <mwilliams@letsgoaero.com>

Thu, Mar 4, 2010 at 4:35 PM

To: "Glenn L. Webb" <glenn@rockymtlaw.com>

----- Forwarded Message

From: "Marty L. Williams" <mwilliams@letsgoaero.com>**Date:** Thu, 04 Mar 2010 15:34:37 -0700**To:** Gail Matheus <gmatheus@cequentgroup.com>**Conversation:** New patent attorney**Subject:** Re: New patent attorney

Hello Gail,

Thanks for the information. We've have not moved to re-activate yet, as we would like input from you, before we make a final decision.

Very Truly,
Marty

Marty,

Trimas has a newly hired IP attorney.

I have forwarded to him your e-mails and our contracts and asked him for his advice.

I'll let you know what he says after he has had a chance to review.

Have you taken any further action on your side?

Gail R. Matheus
General Manager - Cargo Management
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734-679-5019 (Cell)

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Exhibit E